

REMARKS

This is a response to the Non-Final Office Action mailed Feb. 28, 2011. Prior to entry of this paper, claims 1, 3, 7, 8, 10, 11, 14, 18-20, 22, and 26-31 were pending in this application. No claims are amended, canceled, or added by this response. Accordingly, upon entry of this paper, claims 1, 3, 7, 8, 10, 11, 14, 18-20, 22, and 26-31 will remain pending. No new matter is added.

In the Office Action mailed Feb. 28, 2011, claims 1, 3, 7, 8, 10, 11, 14, 18-20, 22, and 26-31 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) claim 22 stands rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter; and
- (B) claims 1, 3, 7, 8, 10, 11, 14, 18-20, 22, and 26-31 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2002/0026353 ("Porat").

These rejections are respectfully traversed.

Examiner Interview

The undersigned thanks Examiner Jason B. Dunham¹ for the courtesies extended during the telephonic Examiner Interview of April 1, 2011 with attorney Davin K. Chin. During the Examiner Interview, the parties discussed the 35 U.S.C. § 101 rejection of claim 22.

More specifically, Mr. Chin requested clarification regarding the suggestion on page 3 of the Office Action to add "non-statutory" to the preamble of claim 22 and inquired whether the Examiner intended to suggest adding "non-transitory" instead of

¹ We note that Examiner Brandy A. Zukanovich is now listed in PAIR as the assigned Examiner for the present application.

"non-statutory[.]" Examiner Dunham indicated that the "non-statutory" suggestion was due to a clerical error and that intended to suggest addition of "non-transitory[.]"

Mr. Chin then argued that the 35 U.S.C. § 101 rejection should be withdrawn at least because the word "storage[.]" which was already in the phrase "computer-readable storage medium" of claim 22's preamble, already brought claim 22 within the patentable subject matter of § 101. Accordingly, addition of "non-transitory" to the preamble of claim 22 would be both unnecessary and redundant. While no agreement was reached regarding the § 101 rejection, Examiner Dunham explained current U.S. Patent Office and art unit guidance regarding examination of computer-readable medium claims.

A. Response to Rejection under 35 U.S.C. § 101

As noted above, claim 22 stands rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Specifically, page 3 of the Office Action states "[c]laim 22 fails to recite a computer program that is embodied on a statutory computer-readable medium, as the medium may merely be directed to non-statutory carrier waves or signals." The Office Action cites no authority to support this allegation. Instead, the Examiner requests that the phrase "non-transitory" be added to the preambles of claim 22.

It is respectfully submitted that claim 22 is already recites patentable subject matter under of 35 U.S.C. § 101, and thus withdrawal of this rejection is respectfully requested. In particular, claim 22 is fully within the patent subject matter of 35 U.S.C. § 101 at least because the preamble of claim 22 recites "[a] computer-readable **storage** medium" (emphasis added). Based on the common usage and understanding of the English language, "signals" and "carrier waves" are not stored, and hence are not within claim 22's scope. In fact, the Office Action's failure to cite any legal or other authority for the allegation that "storage" medium claim 22 covers "signals[.]" "carrier waves[.]" or is otherwise non-statutory, belies the logical flaw in this rejection.

In light of the above remarks, withdrawal of the 35 U.S.C. § 101 rejection is respectfully requested. Should the 35 U.S.C. § 101 rejection be maintained in the next communication, legal authority supporting an interpretation of how a “storage” medium claim covers “signals[,]” “carrier waves[,]” or other non-statutory subject matter is respectfully requested.

B. Response to Rejection under 35 U.S.C. § 102(e)

Claims 1, 3, 7, 8, 10, 11, 14, 18-20, 22, and 26-31 stand rejected under 35 U.S.C. § 102(e) as allegedly unpatentable over Porat.

While the right to later distinguish over Porat is reserved, Porat is now being disqualified as prior art. Filed concurrently herewith are executed declarations under 37 CFR 1.131 (“Rule 131 declaration[s]”) of inventors Peter Gremett and Srinivas Lingutla.

A petition under 37 CFR 1.183 is being filed concurrently herewith in lieu of executed Rule 131 declarations from inventors Kamal Acharya, Vincent Tong, and Matthew Crampton, so as to request waiver or suspension of a requirement for their signatures on the Rule 131 declaration, due to their unavailability and/or unwillingness to review and execute the Rule 131 declaration.

Furthermore, a request under 37 CFR 1.48(a) and related documents are being filed herewith to request deletion of Ellen F. Butler (now Ellen F. Butler Patterson) as an inventor. Hence, she is not listed as an inventor in the Rule 131 declarations.

In view of the deletion of Ellen F. Butler as an inventor, new inventor declarations executed by Peter Gremett and Srinivas Lingutla are also included herewith. A petition under 37 CFR 1.47(a) is being filed concurrently herewith to request that signing inventors Peter Gremett and Srinivas Lingutla be permitted to make the application (including executing declarations) on behalf of themselves and the non-signing inventors Kamal Acharya, Vincent Tong, and Matthew Crampton.

In view of the documents being filed herewith, it is respectfully submitted that Porat is disqualified as prior art. Withdrawal of this rejection is thus respectfully requested.

It is also respectfully noted herein that while Porat claims priority to a provisional application filed on Dec. 22, 1999 ("Porat Provisional"), it is believed that the Porat Provisional does not support 35 U.S.C. § 102 rejections of the pending claims. Accordingly, it is believed that Porat may be disqualified as prior art based on at least a showing of conception with actual reduction to practice of the subject matter of the present application prior to the Dec. 22, 2000 non-provisional filing date of Porat.

Conclusion

In view of the foregoing, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned at (206) 622-1711 if the Examiner believes that an interview might be useful for any reason. It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary, such extensions of time are hereby petitioned under 37 CFR 1.136(a). If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: August 29, 2011

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